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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,427	11/12/2003	James R. January	14045.015US	7160

22870 7590 05/16/2007  
LAURENCE P. COLTON  
1201 WEST PEACHTREE STREET, NW  
14TH FLOOR  
ATLANTA, GA 30309-3488

EXAMINER
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MATZEK, MATTHEW D

ART UNIT	PAPER NUMBER
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1771

MAIL DATE	DELIVERY MODE
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05/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,427	<b>Applicant(s)</b> JANUARY, JAMES R.	
	<b>Examiner</b> Matthew D. Matzek	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-22, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/12/2007 has been entered.

***Response to Amendment***

2. Claims 1, 9, 13 and 19 have been amended and claims 24 and 25 are new. Claims 1-5, 7-22, 24 and 25 are currently active. The previous anticipatory rejection of claim 2 in view of Lovell has been withdrawn due to the claim's amendment to limit the substrate to woven articles.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Applicant recites the limitation "wherein the paint mixture further comprises" in claim 7. There is insufficient antecedent basis for this limitation in the claim. Examiner believes that Applicant intends claim 7 to be dependent from claim 5 and has interpreted the claim as such.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The hydrophilic coating having a low electric resistivity, which is critical or

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essential to the practice of the invention, but included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-5, 6-12, 14-17, 19-22, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lovell (US 5,629,073).

a. Lovell teaches a coated substrate comprising a coating composition and a substrate (pg.1 col.2 lines 6-7). The coated substrate can have a flexible material of cotton. The canvas limitation of claims 3 and 4 are anticipated without further structural limitations for said limitation. The coating composition is about 20-30 and even up to 80 weight percent latex, about 5 to about 50 weight percent dry ingredients, and about 20-30 and as little as 5 to as much as 70 weight percent water (pg.4 col.7 lines 1-7). The coating is a latex and water paint mixture (pg.3 col.5 lines 13-14) comprising surfactants in about 0.1% by weight (pg. 4 col.7 line 34), fillers and extenders (pg.3 col.5 lines 19), defoaming agents in small amounts of up to 0.5% (pg.3 col.6 line 54), dispersing agents (pg.3 col.5 line 54), and pigments such as calcium carbonate and talc (pg.3 col.6 lines 18-21). The extenders can be talc, in about 1 percent by weight (pg.3 col.6 lines 19-20). The aqueous latex paint dispersion, which is hydrophilic, may comprise polyvinyl alcohol or polyvinylpyrrolidone (pg.3 col.5 lines 33-59). From Applicant's specified amounts, the

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following percentages were calculated: 100-200 parts by weight latex, 57-48.5% by weight; 0-5 parts pigment dispersant, 0-1.2%; 0-2 parts defoamer, 0-0.49%; 75-100 parts pigment and filler, 43-24.3%; 0-50 parts extender, 0-12.1%; 0-5 parts surfactant, 0-1.2%, 0-50 parts water, 0-12.1%. Thus, claims 1, 3-12, 14-17, and 19-22 are anticipated. The new limitation of claim, which requires the coating to be hydrophilic, is provided by the Lovell reference because the latex coating is aqueous and is therefore inherently hydrophilic remains so after drying.

*b.* Examiner notes that amended claim 9 and new claim 24 utilize the term “consisting essentially of”. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lovell (US 5,629,073).

a. Lovell fails to teach the use of woven substrates, but does teach that the substrate can be any one of a variety of pliable and fabric-like textile products including those intended for use as garments, wall coverings, floor coverings or the like (col. 3, lines 3-

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10). This teaching encompasses woven substrates and the utilities stated are well known to employ woven materials as substrates and based on that, the selection of woven would be immediately obvious to one of skill in the art.

b. The features of Lovell have been set forth above. Lovell is silent about the specific amount of pigment dispersant, the amount of calcium carbonate included in the paint mixture, and the amount of the water-soluble polymer, which is mixed with the paint mixture. Lovell also fails to teach that the coating comprises a defoamer of 0.3 percent by weight, a surfactant of 0.63 percent by weight, and talc (as the extender) of 6.3 percent by weight of the total paint composition. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the desired percentages through the process of routine experimentation in order to arrive at values, which offered the optimum composition in the invention of Lovell. Thus, claims 13 and 18 are rejected.

#### ***Response to Arguments***

7. Applicant's arguments filed 2/12/2007 have been fully considered but they are not persuasive.

8. Applicant argues that in light of the amended claims the previously applied rejections are moot. Examiner disagrees and has set forth his interpretation of the applied art and rejections *supra*.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is 571.272.2423. The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571.272.1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mdm

*mdm*



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700